

REMARKS

These remarks are in response to the Office Action mailed September 15, 2003. Support for the amendments to claims 1, 2, 4, 5, 9, 10, 12, 13, 20, 24 and 28 can be found in the specification and in original claim 4; claim 21 has been amended to more clearly define the subject matter of interest, and the amendment to claim 31 can be found in the specification and original claim 36. Accordingly, no new matter has been added and entry of the amendment is respectfully requested.

I. The Restriction Requirement

Applicants' election of Group I and traversal were acknowledged. The traversal was found not to be persuasive on the grounds that the libraries are distinct and the search would be burdensome. However, while the Applicants do not acquiesce to the reasoning offered by the Examiner regarding the libraries, there have been no arguments submitted as to why the kits should not be rejoined with claims 1-32, as the components thereof as claimed cannot be practiced without the materials as claimed in the methods. This being the case, a search for the claimed components of the kits would be co-extensive with the methods as claimed. Thus, Applicants respectfully submit that claims 33 and 34 be re-joined with claims 1-32 for the reasons given above.

II. Rejection Under 35 U.S.C. §102

Claims 1-28, 31 and 32 stand rejected under 35 U.S.C. §102(e) as being anticipated by Koster et al (U.S. Pat. No. 6,043,031). Applicants traverse the rejection against these claims, including those as amended, for the reasons given below.

Koster et al. are alleged to teach a mass spectrometry detection method comprising various steps which anticipate the instant methods as claimed. However, Koster et al. expressly recite that:

"[i]n addition, because the instant disclosed processes allow *the nucleic acid fragments to be identified and detected at the same time by their specific molecular weights* (an unambiguous physical standard), the disclosed processes are also much more accurate and reliable than currently available procedures." Column 5, lines 37-42 (emphasis added).

This statement, along with the embodiments as recited and envisaged in the cited reference, indicates that the detector tag is always attached to the oligonucleotide as the identified target for the mass spectrometry methods as described.

Review of the instant claims, as amended, demonstrates that the nucleic acid of interest is identified by detection of a de-linked detector tag (i.e., claims 1-30). Further, the duplexes as claimed would possess a removable detector tag (i.e., claims 31-32).

As stated in Hybritech Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 231 USPQ 81 (Fed. Cir. 1986):

"It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention."

Koster et al. do not teach or suggest a method comprising process steps which include detection of a removed/de-linked detector tag nor oligonucleotides/duplexes comprising removable detector tags. Therefore, the Koster et al. reference does not meet every element of the claimed invention, and thus, does not anticipate the claims as recited.

For the reasons given above, Applicants respectfully submit that the rejection does not apply to the claims as amended and request that the rejection be withdrawn.

III. Rejection Under 35 U.S.C. §103(a)

Claims 29 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Koster et al. in view of Kinzler et al (U.S.Pat. No. 5,695, 973).

Applicants traverse the rejection against these claims, including those as amended, for the reasons given below.

"To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." M.P.E.P. §2143.

The Office Action alleges that Koster et al. teach the limitations of claims 1-28 and 31-32. As discussed above, Koster et al. do not teach or suggest a method comprising process steps which include detection of a removed/de-linked detector tag nor oligonucleotides/duplexes comprising removable detector tags.

While, Kinzler is cited to allegedly cure the deficiencies recited in the Office Action regarding Koster et al. (i.e., alternative separation moieties such as capture using polyA tails or 5' capped nucleic acids), the secondary reference does not cure the primary reference's failure to teach the detection of a removed/de-linked detector tag or oligonucleotides/duplexes comprising removable detector tags as claimed.

As such, because 1) the secondary references fail to cure the deficiencies identified in Koster et al., and 2) the guidance from such references fails to achieve the invention as claimed in the absence of the instant disclosure, Applicants submit that the burden to establish a prima facie case of obviousness can not be met in view of cited references.

For these reasons, Applicants respectfully request that the rejection be withdrawn.

In re Application of:
Wold et al.
Application No.: 09/918,687
Filed: July 27, 2001
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Attorney Docket No.: CIT1410-1

CONCLUSION

Applicants submit that the pending claims are in condition for allowance. Reexamination, reconsideration, withdrawal of the rejections, and early indication of allowance are requested respectfully. If any questions remain, the Examiner is urged to contact the undersigned below.

No fee is believed due in connection with this Amendment. If any additional fees are due, the Commissioner is hereby authorized to charge any fees that may be required by this paper to Deposit Account No. 50-1355. A duplicate copy of this Transmittal Sheet is attached.

Respectfully submitted,

Date: _____

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Lisa A. Haile

Lisa A. Haile, J.D., Ph.D.

Registration No. 38,347

Telephone: (858) 677-1456

Facsimile: (858) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133

USPTO Customer Number 28213